

a server able to detect a valid access code, a remote location identification, and instructions in the information received from the remotely located input terminal;

a remote location able to accept information from a remote server and determine whether said information contains a valid access code;

the ability to convey instructions from said server to a targeted appliance; and control the future behavior of said appliance based on said instructions.

Proof That Figure 7 Is Not New Material

FIG. 7, item 703: Instructions can be inputted from a variety of remote input terminals, "user can communicate with their EA router 120A by keying in DTMF tones, supplying information over the internet or by voice commands over telephone to a Central Site" paragraph [0072].

Fig. 7, item 705: The Central Site can stores information, until it is ready to act on it "In one embodiment, for example, a request may be placed on a Sunday, to record a program that is aired at 9:30 PM on channel 7 Sunday night. At the central site, where the request is logged in, the user's file is located and checked for validity" paragraph [0073].

Fig. 7, item 710: The Central Site can process received information, "converts the user's instructions into DTMF tone ... " paragraph [0072]. "The central site validates the user's identity" Paragraph [0074].

Fig. 7, item 715: "If valid, the user's EA router access code, and model number information are retrieved from the user's record" paragraph [0073].

Fig. 7, item 720: "If valid, the user's EA router access code, and model number information are retrieved from the user's record" paragraph [0073].

Fig. 7, item 725: "This information is used to generate a numeric string that encodes the command instructions that are required to effectuate the recording" paragraph [0073].

Fig. 7, item 725: "In one embodiment, the central site validates the user's identity and collects information regarding the program the user wants to record: day of recording, time of the recording, channel from which to record the program. The central site then generates a string of DTMF tones that encodes the user's access code, channel from which the recording is to be made, the commands to activate the VCR, the commands for rewinding the tape, and the commands for start recording" paragraph [0074].

Fig. 7, item 730: "In this embodiment, the central site sends the code out anywhere from 5 to 10 minutes before the desired recording time. This reduces the size and amount of coding required to be sent. In another embodiment, the string of DTMF tones sent to the EA router 120A contains coding information for selecting date and time. In other embodiments, the central site may allow interaction with the user's device directly" paragraph [0076].

Fig. 7, items 735 & 740: "In one embodiment, the following string of DTMF tones may be transmitted to the EA router 120A. The position and length of each component of the encoded instructions to the recording device is preset, allowing the EA router 120A to easily convert the central site transmitted data string into an access code, instructions codes that mimic the recording device remote control unit, and a termination flag" paragraph [0083].

Fig. 7, item 745: "The central site generates a string of DTMF tones that encodes this information as shown above. In one embodiment the registered EA router's access code is attached to the beginning of the encoded information, and the end of data flag (#) is attached to the end of the encoded information. The access code allows the EA router 120A to determine if the captured string of DTMF-tones should be accepted. The end of data flag tells the EA router 120A when the end of the string of DTMF tones is reached, and that it can now begin to process the string into code signals that will mimic a remote control unit" paragraph [0092]".

Fig. 7, item 745: "In this embodiment, once the string of digits is converted into valid code signal that the recording device recognizes, the instruction codes are transmitted to the recording device. The transmission mode may be in the form of infrared light impulses generated by the infrared diode/transmitter attached to the EA router 120A (FIG. 2A) and received by the recording device infrared detector" paragraph [0098].

Proof That Illustrations 1, 2, and 3 Are Not New Material

Illustration 1, 2, and 3, Step 1: Instructions can be inputted from a variety of remote input terminals, "user can communicate with their instructions for controlling a remotely located appliance by supplying information over the internet, DTMF-tone over a phone, Faxing, or by voice commands over telephone to a Central Site" paragraph [0072] & [0088].

[0072] As describe below, the EA router 120A is able to receive a string of DTMF tones and translate it into a series of digits. The received string of digits contains coded instructions for the EA router 120A. The instructions tell the EA router 120A how to generate signals that access and properly set the recording device to record a desired program. **The user can communicate with their EA router 120A by keying in DTMF tones, supplying information over the internet or by voice commands over telephone to a central site.** The central site converts the user's instructions into DTMF tone and transmits them to the user's EA router 120A. The EA router 120A may communicate with the user's recording device via a variety of methods such as light wave (infrared light) or electronic signals (analog or digital signals).

[0088] As shown in FIG. 2A and explained above, the EA router 120A may receive a string of DTMF tones from the central site and convert them into light signals that may be communicated to the recording device via the infrared emitter 192 (FIG. 2A) attached to the stamp/micro-controller 124. **An EA router user may enter information about what programs are to be recorded via the internet, wire/wireless phone, fax, etc.**

Illustration 1, 2, and 3, Step 2: Instructions are transmitted from an input device over a communication network to a central site. Specifications in paragraphs [0006], [0015] & [0016] clearly state that the EA-Router is attached to a Public Switch Telephone Network (a.k.a. PSTN), or an Internet connection would be suitable means for passing instruction on to the central site. Figure 1, shows the EA-Router attached to a PSTN.

[0006] The remote user can contact the central site via any Internet accessing device, phone (wire/wireless), fax, etc. The user may then supply requested information to enable the central site to access and set the user's recording device. The enhanced automatic router (EA router) may be attached to a modified Caller ID Box, a phone line with a standard answering machine, a computer, a cable line, etc. The media recording device can be one of a variety of media storage devices including, but not limited to, tape (e.g., VCR), digital (e.g., TiVo), laser (write-able compact disk), etc.

[0015] FIG. 1 shows one embodiment of a system incorporating the present invention. In this embodiment, the system includes telephones or user interface devices 110 and 110'. Although the interface user device, in one embodiment, is a telephone, in an alternate embodiment, user interface devices 110 and 110' may be a facsimile, computer, online access device, voice response unit or the like. It should be noted that although references are made herein to telephones and user interface devices, these terms are used interchangeably and may include the other user interface devices listed above, as well as those that are not listed herein, that utilize telephony services to effectuate communication over

network 100. It should be noted that the difference between user interface devices 110 and 110' is the devices' connection with automatic router 120 which is described in detail below (i.e., 110' denotes that the device is connected to router 120, while 110 has no such router 120 connected to it).

[0016] As shown in FIG. 1, user interface devices or telephones 110 and 110' are connected to a network 100. Network 100 in one embodiment is a public switched telephone network (PSTN). In an alternate embodiment, network 100 may be the internet, world wide web or any network capable of effectuating long distance telephony communications between users. The network enables any one of the interface user devices 110 and/or 110' to be in communication with any of the other user interface devices 110 and/or 110'.

Illustration 1, 2, and 3, Step 3: Instructions are transmitted from an input device over a communication network to a central site. Specifications in paragraphs [0072] clearly states that "The user can communicate ... to a central site".

[0072] As describe below, the EA router 120A is able to receive a string of DTMF tones and translate it into a series of digits. The received string of digits contains coded instructions for the EA router 120A. The instructions tell the EA router 120A how to generate signals that access and properly set the recording device to record a desired program. **The user can communicate with their EA router 120A by keying in DTMF tones, supplying information over the internet or by voice commands over telephone to a central site.** The central site converts the user's instructions into DTMF tone and

transmits them to the user's EA router 120A. The EA router 120A may communicate with the user's recording device via a variety of methods such as light wave (infrared light) or electronic signals (analog or digital signals).

Illustration 1, 2, and 3, Step 4: Instructions / information received at the central site is process before being forwarded. Specifications in paragraphs [0072] clearly states that information / instructions are both process and stored at the central site "The central site converts the user's instructions into DTMF tone and transmits them to the user's EA router 120A", and paragraph [0073] "At the central site, where the request is logged in, the user's file is located and checked for validity. If valid, the user's EA router access code, and model number information are retrieved from the user's record. This information is used to generate a numeric string that encodes the command instructions that are required to effectuate the recording".

[0072] As describe below, the EA router 120A is able to receive a string of DTMF tones and translate it into a series of digits. The received string of digits contains coded instructions for the EA router 120A. The instructions tell the EA router 120A how to generate signals that access and properly set the recording device to record a desired program. The user can communicate with their EA router 120A by keying in DTMF tones, supplying information over the internet or by voice commands over telephone to a central site. **The central site converts the user's instructions into DTMF tone and transmits them to the user's EA router 120A.** The EA router 120A may communicate with the user's recording device via a variety of methods such as light wave (infrared light) or electronic signals

[0073] In one embodiment, for example, a request may be placed on a Sunday, to record a program that is aired at 9:30 PM on channel 7 Sunday night. At the central site, where the request is logged in, the user's file is located and checked for validity. If valid, the user's EA router access code, and model number information are retrieved from the user's record. This information is used to generate a numeric string that encodes the command instructions that are required to effectuate the recording. Since each manufacturer may use different remote control codes/pulses for a given digit or command, each user must register the type, brand, and model of their recording device in order to ensure that the EA router 120A can function properly. Panasonic, RCA and Toshiba VCRs, for example, may be encoded to start recording with a 123 cycle (c.p.s.) of duration 20 ms, 210 c.p.s. for 15 ms, and 30 c.p.s. for 50 ms, respectively. In this embodiment, pulses refer to the number of impulse (light/electrical) to be generated in one second. This difference in command coding makes it necessary for each user to register the make and model of their recording device.

Illustration 1, 2, and 3, Step 5 & Step 6: the central site forwards coded Instructions to a EA-Router at a remote location. Specifications in paragraphs [0102] clearly states that information / instructions are forwarded from the central site to a remote location over a communication network "It should be noted that the example above describes accessing a media recording device by a user over a telephone line. It should be noted that many other types of communication networks may be used including, but not limited to, the internet, cable networks, wireless networks, etc." and paragraph [0075] "EA router 120A, in this

embodiment, recognizes that the central site sends a string of DTMF tones in a predetermined format.”.

[0102] It should be noted that the example above describes accessing a media recording device by a user over a telephone line. **It should be noted that many other types of communication networks may be used including, but not limited to, the internet, cable networks, wireless networks, etc.** Further, although the example above describes an infrared emitter 192 accessing a media recording device, the emitter 192 may be replaced with another type of emitter (i.e., infrared, ultra-violet, RF, electrical signals, blue tooth technology) and the activated device may be any device that can receive such a signal.

[0075]**EA router 120A, in this embodiment, recognizes that the central site sends a string of DTMF tones in a predetermined format.** This allows the EA router 120A to convert the captured DTMF tone sequence into a numeric string that can be segmented into both remote control command codes and access codes. The access codes allows the EA router 120A to recognize that the instructions come from an authorized VCR user. The command codes allows the EA router 120A to turn on the VCR, rewind the tape in the VCR, select the channel to record and then start recording.

Illustration 1, 2, and 3, Step 7: the EA-Router conveys the instruction from the Central Site to the targeted VCR. Specifications in paragraphs [0075] & [0102] clearly states that a variety of methods for relaying instructions from the EA-Router to the VCR

“Further, although the example above describes an infrared emitter 192 accessing a media recording device, the emitter 192 may be replaced with another type of emitter (i.e., infrared, ultra-violet, RF, electrical signals, blue tooth technology) and the activated device may be any device that can receive such a signal [0102]” and **“the instruction codes are transmitted to the recording device. The transmission mode may be in the form a direct electrical line between the two devices (EA-Router and Recording Device). The instructions may go directly to a microprocessor/micro-controller inside of recording device”.**

[0102] It should be noted that the example above describes accessing a media recording device by a user over a telephone line. It should be noted that many other types of communication networks may be used including, but not limited to, the internet, cable networks, wireless networks, etc. **Further, although the example above describes an infrared emitter 192 accessing a media recording device, the emitter 192 may be replaced with another type of emitter (i.e., infrared, ultra-violet, RF, electrical signals, blue tooth technology) and the activated device may be any device that can receive such a signal.**

[0099] In another embodiment, once the string of digits is converted into validcode signal that the recording device recognizes, **the instruction codes are transmitted to the recording device. The transmission mode may be in the form a direct electrical line between the two devices (EA-Router and Recording Device). The instructions may go directly to a microprocessor/micro-controller inside of recording device. This may obviate the need for an infrared light sensor in the recording**

device, and permit greater flexibility in the control of the user's recording device.

Illustration 1, 2, and 3, Step 8: the instruction from the Central Site control the behavior of the VCR. Specifications in paragraph [0075] clearly states that "The command codes allows the EA router 120A to turn on the VCR, rewind the tape in the VCR, select the channel to record and then start recording [0075]" and **"the instruction codes are transmitted to the recording device. The transmission mode may be in the form a direct electrical line between the two devices (EA-Router and Recording Device). The instructions may go directly to a microprocessor/micro-controller inside of recording device"**.

[0075]EA router 120A, in this embodiment, recognizes that the central site sends a string of DTMF tones in a predetermined format. This allows the EA router 120A to convert the captured DTMF tone sequence into a numeric string that can be segmented into both remote control command codes and access codes. The access codes allows the EA router 120A to recognize that the instructions come from an authorized VCR user. **The command codes allows the EA router 120A to turn on the VCR, rewind the tape in the VCR, select the channel to record and then start recording.**

Cited Material Used To Defend Applicant's Patent Application

A.

173.05(e) Lack of Antecedent Basis [R-1] - 2100 Patentability

2173.05(e) Lack of Antecedent Basis [R-1]

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of "said lever" in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended. A claim which refers to "said aluminum lever," but recites only "a lever" earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made. Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. >See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse"

provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").<

EXAMINER SHOULD SUGGEST CORRECTIONS TO ANTECEDENT PROBLEMS

Antecedent problems in the claims are typically drafting oversights that are easily corrected once they are brought to the attention of applicant. The examiner's task of making sure the claim language complies with the requirements of the statute should be carried out in a positive and constructive way, so that minor problems can be identified and easily corrected, and so that the major effort is expended on more substantive issues. However, even though indefiniteness in claim language is of semantic origin, it is not rendered unobjectionable simply because it could have been corrected. *In re Hammack*, 427 F.2d 1384 n.5, 166 USPQ 209 n.5 (CCPA 1970).

**A CLAIM TERM WHICH HAS NO ANTECEDENT BASIS IN THE DISCLOSURE IS NOT
NECESSARILY INDEFINITE**

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

**A CLAIM IS NOT PER SE INDEFINITE IF THE BODY OF THE CLAIM RECITES
ADDITIONAL ELEMENTS WHICH DO NOT APPEAR IN THE PREAMBLE**

The mere fact that the body of a claim recites additional elements which do not appear in the claim's preamble does not render the

claim indefinite under 35 U.S.C 112, second paragraph. See *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The examiner rejected the claim under 35 U.S.C 112, second paragraph, because the omission from the claim's preamble of a critical element (i.e., a linear member) renders that claim indefinite. The court reversed the examiner's rejection and stated that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C 112, paragraph 2.).

B.

The following ground(s) of rejection are applicable to the appealed claims:

Examiner Note:

Explain each ground of rejection or refer to the single prior Office action which clearly sets forth the rejection and complies with appropriate paragraphs i - vi below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the Examiner's Answer or a single prior action, shall explain how the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any, (a) do not describe the subject matter defined by each of the rejected claims, (b)

would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and (c) do not set forth the best mode contemplated by the appellant of carrying out his/her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the Examiner's Answer or single prior action, shall explain how the claims do not particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the Examiner's Answer or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the Examiner's Answer or single prior action, shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection, shall identify any difference between the rejected claims and the prior art relied on and shall explain how the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the Examiner's Answer, or single prior action, shall explain the rationale for making the combination.

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (ii),

(iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the specific page, line number, drawing reference number and quotation from the prior art, as appropriate.

C.

C1. [HN3] Anticipation is a question of fact. In order to anticipate, there must be identity of invention; thus, the claimed invention, as described in appropriately construed claims, must be the same as that of the reference. More specifically, under 35 USCS 102 (b), a patent claim is anticipated by a prior art reference if the reference discloses, either expressly or inherently, each and every element of the claimed patent. Every element of a claimed invention must be identically shown in a single reference for a prior art reference to anticipate. (Danny J. Elder and Enviro-Stain, Inc. Plaintiffs, v A.S.Tanner and Tanner Forest Products, Corp., Defendants; Case No. 1:98-CV-36; United States District Court For the Eastern District Of Texas, Beaumont Division; 180 F. Supp. 2nd 818; 2001 U.S. Dist. LEXIS 23054)

C2. [HN31] The test of obviousness in 35 U.S.C.S. § 103 is the primary condition of patentability. Obviousness hinges on four factual findings: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. Metabolite laboratories, Inc. and Competitive Technologies, Inc., Plaintiffs-Appellees, v Laboratory Corporation Of America Holding (doing business as LabCorp),

Defendant-Appellant. United State Court Of Appeals For The Federal
Circuit 2004 U.S. App. LEXIS 11248

C3. [HN1] The presumption of patent validity must be overcome by clear and convincing evidence, and the patents commercial success and the failure of competitors to develop equally successful inventions are important factors weighting in favor of the validity of the patents. In addressing the question of obviousness, a judge must not pick and choose isolated elements from the prior art and combine them so as to yield the invention in question if such a combination would not have been obvious at the time of the invention.

475 US 809, *; 106 S. Ct. 1578, **;
89 L. Ed. 2d. 817, ***; 1986 U.S. LEXIS 100

DENNISON MANUFACTURING CO. V. PANDUIT CORP.

No. 85 - 1150

SUPREME COURT OF THE UNITED STATES

475 US 809, *; 106 S. Ct. 1578; 89 L. Ed. 2d. 817; 1986 U.S. LEXIS 100; 54
U.S.L.W. 3695; 229 U.SP.Q. (BNA) 478; 4 Fed. R. Serv. 3d (Callaghan) 366

C4. 535 F2d 67 *; 1976 CCPA LEXIS 162, **; 190 U.S.P.Q. (BNA) 15

IN THE MATTER OF THE APPLICATION OF MAMORU HIRAO AND YOSHINORI SATO

Patent Appeal No. 76-560

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MAY 27, 1976 DECIDED

In "Hirao" it reads on a patent can contain both unique and obvious components, so long as these components are applied in a unique manner they are patentable.

Interview

Applicant forward an informal copy of this Response To Office Action at talking points. Applicant reviewed what was believed to be the cause of the antecedent "the" as appose to "a". Examiner agreed that the changing "the" to "a" would resolve the problem.

Applicant reviewed what he believed to be shortcoming in Noonen et al's patent as anticipatory to his invention. The agree that the stated shortcoming were valid as stated by the Applicant, and that the Examiner would review the material to be sure Applicant's statement was accurate.

The Applicant stated that Noonen et al, Irie, and Chang et al patents combine did not reveal all of the aspect of the Applicant's invention, therefore fail to make said invention obvious. Applicant reference Table 2 in this Response To Office Action. The Examiner would review the material to be sure Applicant's statement was accurate.

Applicant reviewed Claim 27 with the Examiner, and stated where the supporting material was located. Later the Applicant's called and asked if the Examiner wanted Figure 6, re-graphed to reflex the details of the Patent Application.

Applicant reviewed Claim 29 & 30 regarding time delay and the server being able to initiate act on its own. The Applicant cited the location of the supporting material in the patent application to the Examiner.

Applicant expressed his desire for a speedy review of the Response To Office Action, and upon verification the issuing of allowance. The Examiner, explained that everything is contingent upon a possible future search.

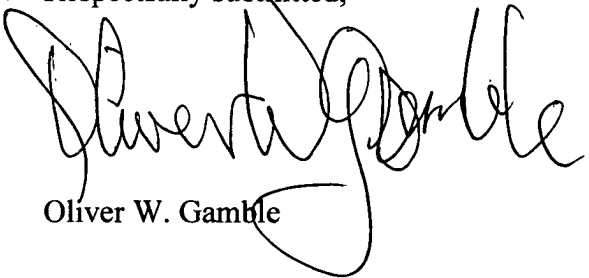
Application Number: 09/803,257
Office Action Date: December 15, 2005

Art Unit 2645

Examiner: Ming Chow
Filed On: 03/09/2001

The Applicant's has amended the claims; correcting the flaws and defects pointed out by the Examiner. The Applicant respectfully requests that the Examiners review the Applicant's response to the Final Office Action (Applicant's arguments and supporting material) and grant a patent.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Oliver W. Gamble". The signature is stylized with large, flowing loops and a prominent initial "O".

Oliver W. Gamble